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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,238

04/04/2005

Kumiko Ono

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EXAMINER

SCHWARTZ, DARREN B

ART UNIT

PAPER NUMBER

2135

MAIL DATE

DELIVERY MODE

09/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/530,238	ONO ET AL.	
	Examiner	Art Unit	
	DARREN SCHWARTZ	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 37-58 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 7-9 and 37-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-6 and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04-04-05 01-10-08</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Species 2 of Group I in the reply filed on 23 June 2008 is acknowledged.

Claims 1-4, 7-9 and 37-58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species and groups, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 21 July 2008.

Applicant's believe claims 7-9 should be categorized into not only Species 1, but also Species 2 on the grounds that claim 7, from which claims 8 and 9 directly depend, as reciting a terminal operation related to receiving and sending of a public key certificate and a server operation responsive to the terminal operation. This is not found persuasive because claim 7 contains the distinct limitation "a mean which generates an asymmetric key pair" directed to Figure 2, element 114 (Species 1).

The requirement is still deemed proper and is therefore made FINAL.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claims 14 and 15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 5-6 and 10-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language in the claim raises an issue because the claims are directed to nonfunctional descriptive material (i.e. units), and as such, the claim would be directed to non-statutory subject matter.

A data structure is defined as a physical or logical relationship among data elements, designed to support specific data manipulation functions. As claimed, a receiving unit, a unit which receives said request, a unit which stores said public key certificate, etc and is therefore non-statutory nonfunctional descriptive material. Arrangements of data without any functional interrelationship are not a process, machine, manufacture or composition of matter. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. § 101.

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3. Claims 12-13 are further rejected under 35 U.S.C. 101 because the claims for the invention are directed to non-statutory subject matter, as they do not fall under any of the statutory classes of inventions. The language in the claims raise an issue because the claims are directed merely to an abstract idea that is not tied to an article of manufacture which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

The claims could reasonably be drawn to functional descriptive material, per se, i.e., "program" may be taken to mean software alone, and as such, the claims would be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-6 and 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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It is unclear as to the meaning of the limitation, “a sending unit which notifies said public key certificate.”

Any claim not specifically addressed above is being rejected as incorporating the deficiencies of a claim upon which it depends.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 5-6 and 10-15, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Huitema et al (U.S. Pat Pub 2003/0056094 A1), hereinafter referred to as Huitema.

Re claim 5: Huitema teaches a session control server which is connected via a network to a plurality of communication devices so as to be able to communicate with the communication devices, and which, by receiving a signal which is sent from a communication device on a signal originating side, and sending the signal which it has received to a communication device on the signal reception side, establishes a session between said communication device on the signal originating side and said communication device on the signal reception side (¶31), comprising:

a receiving unit which receives a location registration request from said communication device, and a certificate issuance request or a certificate registration request for a public key, as a combined request; a unit which receives said request, and

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which performs issuance of a public key certificate, or confirms the validity of said public key certificate ; and a unit which stores said public key certificate which has been issued or registered and location information, along with a term of validity (see at least:

Abstract, ¶¶8-¶¶9; ¶¶48).

Re claim 6: Huitema teaches a receiving unit which receives an inquiry request for said public key certificate; and a sending unit which notifies said public key certificate, after having confirmed the validity of said public key certificate (¶¶8; ¶¶14; ¶¶41-¶¶42; ¶¶48).

Re claim 10: Huitema teaches a communication method for mutually establishing a session with a communication device, which is connected via a network so as to be capable of communication (¶¶31), wherein:

a session control server, when it receives a request signal from a communication device for location registration and certificate issuance, determines the type of the signal, and, if it is a location registration request, makes a decision as to whether or not it includes a certificate issuance request, and, if an issuance request is included within said signal, issues a certificate, and along with managing said location information and said certificate, sends a signal for location information and certificate issuance completion to said communication device (see at least: Abstract, ¶¶8-¶¶9; ¶¶41).

Re claim 11: Huitema teaches a communication method for mutually establishing a session with a communication device, which is connected via a network so as to be capable of communication (¶¶31), wherein:

a session control server, when it receives a certificate query request signal from a communication device, along with performing session control, decides whether or not it is addressed to its own domain, and, if it is addressed to its own domain, determines the type of the signal, and if it is a certificate query request, decides whether or not a certificate is present, and if there is a certificate, searches a corresponding certificate, confirms the validity of the certificate which has been searched, and sends a certificate notification to said communication device; while, if it is not addressed to its own domain, it transfers said certificate query request signal to the destination session control server (¶43; ¶45-¶46).

Re claim 12: Huitema teaches a program for communication for mutually establishing a session with a communication device, which is connected via a network so as to be capable of communication (¶21; ¶31), for causing a computer of a session control server to execute:

a procedure of receiving a request signal for location registration and certificate issuance from a communication device; a procedure of determining the type of the signal; a procedure of, if it is a location registration request, deciding whether or not it includes a certificate issuance request; a procedure of, if it includes an issuance request, issuing a certificate; a procedure of managing said location information and said certificate; and a procedure of sending a signal of location information and certificate issuance completion notification to said communication device (see at least: Abstract, ¶8-¶9; ¶41).

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Re claim 13: Huitema teaches a program for communication for mutually establishing a session with a communication device (§21; §31), which is connected via a network so as to be capable of communication, for causing a computer of a session control server to execute:

a procedure of receiving a request signal for location registration and certificate issuance from a communication device; a procedure of performing session control; a procedure of deciding whether or not it is addressed to its own domain; a procedure of, if it is addressed to its own domain, determining the type of the signal; a procedure of, if it is a certificate query request, determining whether or not there is a certificate; a procedure of, if there is a certificate, searching a corresponding certificate; a procedure of confirming the validity of a certificate which has been searched; and a procedure of sending a certificate notification to said communication device; and a procedure of, if it is not addressed to its own domain, transferring said certificate query request signal to the destination session control server (see at least: Abstract, §8-§9; §41; §43; §45-§46).

Re claim 14: Huitema teaches a computer readable recording medium, in which a program for communication according to claim 12 is recorded (§26).

Re claim 15: Huitema teaches a computer readable recording medium, in which a program for communication according to claim 13 is recorded (§26).

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although

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the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the text of the passage taught by the prior art or disclosed by the examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat 5768519 A

U.S. Pat Pub 2003/0033521 A1

U.S. Pat Pub 2003/0233418 A1

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARREN SCHWARTZ whose telephone number is (571)270-3850. The examiner can normally be reached on 8am-4pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571)272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S./
Examiner, Art Unit 2135

/KimYen Vu/

Supervisory Patent Examiner, Art Unit 2135